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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,365	10/25/2001	Clive P. Hohberger	7887/83892	2321

7590 11/03/2003  
Welsh & Katz, Ltd.  
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120 South Riverside Plaza  
Chicago, IL 60606

EXAMINER
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COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

10/001,365

Applicant(s)

HOHBERGER ET AL.

Examiner

Dan Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 126-140 and 164-172 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 126-140 and 164-172 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Claim Objections*

1. Claims 127, 130 and 164-172 objected to because of the following informalities:

In claim 127, it appears that “adopted” should actually be --adapted.--

In claim 130, “said media having an associated element” has no proper antecedent basis in the claims. It is not clear if applicant is referring to the value-adding element (is so, then the recitation of “an associated element” would appear to be a double recitation) or if applicant is intending to recite new structure.

In claim 164, line 5, it appears that “appeal” should actually be --apparel.--

In claim 164, line 7, it appears that the second occurrence of “or” should actually be --of.--

In the last line of claim 164, it is unclear how a “class of prospects” can give a response. Perhaps applicant intended to mean, --evoke a predetermined response from said transponders in regard to said class of prospects.—

In claim 167, “said value-adding element” has no antecedent basis in the claims. Thus, “a second value-adding element” is not clear since a first has not been recited.

In claim 168, it is not clear if applicant is intending to recite a second RFID transponder or is intending to further limit the previously recited transponder(s).

Similarly, in claim 170, it is not clear if applicant is reciting an additional transponder or is further limiting the previously recited transponder(s).

In claim 172, “a second value-adding element” is unclear since no first value-adding element has been previously recited.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 126 is rejected under 35 U.S.C. 102(e) as being anticipated by Kromer et al.

Kromer et al. discloses a carrier strip 11 containing labels 12 every other label having a value-adding element 22 as shown in Figure 3 of Kromer et al.

4. Claims 164 and 169 are rejected under 35 U.S.C. 102(e) as being anticipated by Fox et al.

With respect to claim 164, Fox et al. discloses a label with a RFID transponder 112. The transponder may contain information about the item the label is applied to. Fox et al. gives an example of a luggage having a tag with a label containing both printed and RFID information about individual items of luggage (Fox et al., col. 5, lines 11-19). This information is coordinated (as previously mentioned and integrated (disposed on the same tag).

With respect to claim 169, Fox et al. discloses a plurality of transponders 112 some of which can be considered value-adding elements. Since this is an apparatus claim, the method of how the elements are applied holds no patentable weight.

Art Unit: 2854

5. Claims 164, 170 and 171 are rejected under 35 U.S.C. 102(e) as being anticipated by Palmer et al.

With respect to claim 164, Palmer et al. discloses a label with a RFID transponder as shown in Figures 1-2 of Palmer et al. The transponder may contain information about the item the label is applied to as mentioned in col. 1, lines 11-19 of Palmer et al. This information is coordinated and integrated (disposed on the same tag). Furthermore, Palmer et al. discloses printing information on the label as well (col. 1, lines 55-58).

With respect to claim 170, Palmer et al. discloses that the transponder can be chipless (col. 2, lines 34-37).

With respect claim 171, Palmer et al. discloses that the transponder may be programmed (col. 6, lines 6-8).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 127 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kromer et al., as applied to claim 126 above, and further in view of the Transponder News Article.

Kromer et al. discloses the claimed article except for the antenna structure on the media. However, the article in Transponder News teaches that it is known to print an antenna of an RFID label on the label media (paragraphs 1-4). It would have been obvious to combine the

Art Unit: 2854

teaching of Transponder News with the article disclosed by Kromer et al. for the cost-reduction provided by printing antennas with conductive ink rather than more costly materials such as metal coils.

8. Claims 128-130, 133, 134 and 139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kromer et al., as applied to claim 126 above, and further in view of Heredia et al.

With respect to claim 128, Kromer et al. discloses the claimed article except that it is not clear if the valued-adding element is a transponder. In col. 4, lines 28-34, Kromer et al. discloses that the valued-adding element can be a security element that is excitable by electromagnetic, radio or acoustic frequencies. Heredia et al. teaches a carrier web 22 with labels 23 which include a transponder chip 26 as shown in Figures 1-3 of Heredia et al. It would have been obvious to combine the teaching of Heredia et al. with the article disclosed by Kromer et al. for the advantage of identifying and discarding faulty transponders when producing the label (Heredia et al., col. 5, lines 55-58).

With respect to claim 129, 133 and 134, Heredia et al. teaches marking transponders that have failed a functionality test as “defective” (Heredia et al., col. 2, lines 31-40).

With respect to claim 130, the media and transponder can have label data as described in col. 1, lines 66-67 and col. 2, lines 1-35 of Heredia et al.

With respect to claim 139, after the transponders are tested by antenna 20, the faulty transponders are marked as defective and the functional transponders are not marked as defective and therefore are treated differently in postprocessing (processing after the test).

Art Unit: 2854

9. Claims 131-132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kromer et al., as applied to claim 126 above, and further in view of MacGregor et al.

With respect to claims 131-132, Kromer et al. discloses the recited article except for the second media. However, MacGregor et al. discloses a label which includes a second media 22 which can be a promotional device such as game piece or coupon as shown in Figure 1 of MacGregor et al. It would have been obvious to combine the teaching of MacGregor et al. with the article disclosed by Kromer for the advantage of providing an incentive to buy a product that the label may be disposed on while reducing theft due to the security label.

10. Claims 135-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kromer et al., as applied to claim 126 above, and further in view of Moritaki et al.

Kromer et al. discloses the claimed article except for the different characteristics of the plurality of media. However, Moritaki et al. teaches a carrier carrying a plurality of media with different sizes or shapes as shown in Figure 10(e) of Moritaki et al. It would have been obvious to combine the teaching of Moritaki et al. with the article disclosed by Kromer et al. for the advantage of printing labels of different sizes or shapes for different sized products or for different portions of one product.

11. Claims 137-138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kromer et al., as applied to claim 126 above, and further in view of Otto.

With respect to claims 137-138, Kromer et al. discloses the claimed article except for the plurality of elements with different characteristics. However, Otto teaches a label 12 with a

Art Unit: 2854

transponder which has a plurality of elements 22-122-7, 24 and 26 as shown in Figure 2 of Otto.

It would have been obvious to combine the teaching of Otto with the article disclosed by Kromer et al. for the advantage of antenna 26 which indicates that the label 12 is within range of the label interrogator 14 (Otto, pg. 2, paragraph 24).

12. Claim 140 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kromer et al., as applied to claim 126 above, and further in view of Matsuno.

Kromer et al. discloses the claimed article except that he is silent on whether the media is adapted to be applied in groups. However, Matsuno teaches labels 20 that are adapted to show the number of elements in a group as shown in Figure 1 of Matsuno. It would have been obvious to combine the teaching of Matsuno with the article disclosed by Kromer et al. for the advantage of indicating that a group of articles are related by the indicia on their labels.

13. Claims 165-167 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al., as applied to claims 164 and 169 above, and further in view of Otto.

With respect to claim 165, Fox et al. discloses the claimed media except for the plurality of transponders. However, Otto teaches a label 12 with a plurality of transponders 22-1--22-7, 24 and 26 as shown in Figure 2 of Otto. It would have been obvious to combine the teaching of Otto with the media disclosed by Fox et al. for the advantage of antenna 26 which indicates that the label 12 is within range of the label interrogator 14 (Otto, pg. 2, paragraph 24).

With respect to claim 166, Fox et al. discloses that the transponder 112 can be programmed by a write head 44 which gives instructions to the transponder 112.



Art Unit: 2854

With respect to claim 167, Otto teaches a group of antennas which produce related data bit signals to create an identification number (Otto, pg. 2, paragraph 0022).

14. Claim 168 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al., as applied to claims 164 and 169 above, and further in view of Gustafson.

Fox et al. discloses the claimed media except that it is not known to the examiner if the transponder is peelable. However, Gustafson teaches a detaching portion 17 used for peeling transponder as shown in Figure 10 and mentioned in col. 7, lines 46-59 of Gustafson. It would have been obvious to combine the teaching of Gustafson with the media disclosed by Fox et al. for the advantage of indicating if the transponder circuit has been tampered with.

15. Claim 172 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al., as applied to claims 164, 170 and 171 above, and further in view of Otto.

Palmer et al. discloses the claimed media except for the second value-adding element. Otto teaches a group of antennas which produce related data bit signals to create an identification number (Otto, pg. 2, paragraph 0022). It would have been obvious to combine the teaching of Otto with the media disclosed by Palmer et al. for the advantage of antenna 26 which indicates that the label 12 is within range of the label interrogator 14 (Otto, pg. 2, paragraph 24).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (703) 308-2259. The examiner can normally be reached M-F, 8:30-5:30. Faxes regarding this application can be sent to (703) 872 - 9306.

17.

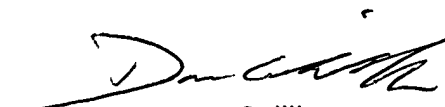
Application/Control Number: 10/001,365

Page 9

Art Unit: 2854

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (703)305-6619. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

October 30, 2003



Dan Colilla  
Primary Examiner  
Art Unit 2854